



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/458,533	12/09/1999	CHANGMING LI	99.743	8944

7590

01/14/2003

ROBIN M. SILVA, ESQ.
FLEHR HOHBACH TEST ALBRITTON AND HERBERT, LLP
FOUR EMBARCADERO CENTER
SUITE 3400
SAN FRANCISCO, CA 94111

EXAMINER

SISSON, BRADLEY L

ART UNIT

PAPER NUMBER

1634

DATE MAILED: 01/14/2003

29

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/458,533

Applicant(s)

LI ET AL.

Examiner

Bradley L. Sisson

Art Unit

1634

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 October 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 28-55 is/are pending in the application.
- 4a) Of the above claim(s) 28-36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 37-55 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 December 1999 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Drawings

1. New corrected drawings are required in this application because they have been objected to for reasons stated on the PTO-948 that was attached to Paper No. 20, mailed 06 November 2001. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

Election/Restrictions

2. Claims 28-35 remain withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 9.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 1634

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 36-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heller et al., in view of Guttman et al., and Anderson et al.

7. Heller et al., disclose an apparatus comprising microelectrodes to be used in the detection of molecular interactions between an immobilized oligonucleotide probe and a target nucleic acid molecule. Column 12 discloses that electrodes may be comprised of silver, platinum as well as alternative metals (lines 55-59). The aspect of having the electrodes insulated through the use of materials such as SiO₂ is disclosed at column 13, first full paragraph. The aspect of having gel pads, such as polyacrylamide gel, incorporated into the device is disclosed at column 15, second paragraph. The aspect of using the apparatus to carry out a

Art Unit: 1634

variety of multi-step and/or multiplex reactions and procedures, including nucleic acid hybridization procedures, is disclosed at columns 16-19. At column 19 there is disclosed the incorporation of detection means.

8. Heller et al., do not disclose the incorporation of detection means.

9. Guttman et al., abstract and column 3, teach the use of an acetate buffer in combination with electrodes and electrophoretic methods.

10. Neither Heller et al., nor Guttman et al., disclose the use of lithium acetate at a concentration of 0.1 M. It is noted that claim 12 defines the concentration of lithium acetate as being (about 0.1 M.” The term “about” is considered to encompass values above and below the identified point. Further, the limit of what constitutes ‘about’ has not been defined and is therefore open to consideration. Accordingly, while neither prior art reference discloses this specific data point, the selection of one concentration of reactants over another concentration of reactants is considered to be, in the absence of convincing evidence to the contrary, the result of routine optimization.

11. Anderson et al., columns 60-61, disclose the incorporation of detection means whereby impedance of a target nucleic acid is measured between electrodes. Such a teaching meets the limitation of claims 36 and 37 wherein part d) a detector is connected to the microelectrodes.

12. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the acetate buffer disclosed by Guttman et al., with the device of Heller et al., as Guttman et al., teach at column 6 that the buffer and its pH are important, as is the presence of molecular sieving medium, and that the use of their buffer provides improved quantitative data. It would have also been obvious to said ordinary artisan to have incorporated

Art Unit: 1634

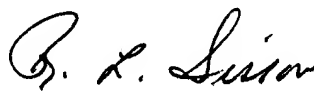
the detection means of measuring the impedance of a target nucleic acid as disclosed by Anderson et al. as Anderson et al., teaches explicitly of using impedance measurements to detect nucleic acids. Accordingly, and in the absence of convincing evidence to the contrary, the ordinary artisan would have been both motivated and would have had a reasonable expectation of success as the state of the art had advanced to the point that it was quite reproducible.

Conclusion

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley L. Sisson whose telephone number is (703) 308-3978. The examiner can normally be reached on 6:30 a.m. to 5 p.m., Monday through Thursday.

14. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W. Gary Jones can be reached on (703) 308-1152. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9307 for After Final communications.

15. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.



Bradley L. Sisson
Primary Examiner
Art Unit 1634